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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|--------------------------------------|-----------------------------|
| 10/815,617 | 04/02/2004 | Kia Silverbrook | HYG009US | 9393 |
| 24011 7590 08/19/2009 SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, 2041 AUSTRALIA | | | EXAMINER FRANKLIN, JAMARA ALZAIDA | |
| | | | ART UNIT 2876 | PAPER NUMBER |
| | | | NOTIFICATION DATE 08/19/2009 | DELIVERY MODE ELECTRONIC |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/815,617

Applicant(s)

SILVERBROOK ET AL.

Examiner

JAMARA A. FRANKLIN

Art Unit

2876

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/30/09.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8, 9, 33, 34, 48-50, 52, 53, 57, 59 and 60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8, 9, 33, 34, 48-50, 52, 53, 57, 59 and 60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgment is made of the amendment filed on 4/30/09. Claims 8, 9, 33, 34, 48-50, 52, 53, 57, 59, and 60 are currently pending.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 8, 9, 33, 34, 48-50, 52, 53, 57, 59, and 60 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 57 and 59, the limitation citing "determining from the position information that the sensing data is indicative of a communication request associated with a provider of the product item" is vague and indefinite since the claim language does not set forth a clear understanding of how indication of a communication request can be determined from position information. Does the position information point to a location that is indicative of a communication request? Is the position information itself a communication request?

Furthermore regarding the limitation citing "determining from the position information that the sensing data is indicative of a communication request associated with a provider of the product item", the claim language does not set forth a clear understanding of how this communication request is associated with a provider of the product. Is the communication

request a request to be sent to the provider of the product? Is this communication request a request generated and sent by the provider of the product item?

Appropriate correction or clarification is required.

Allowable Subject Matter

3. Claims 8, 9, 33, 34, 48-50, 52, 53, 57, 59, and 60 are allowable over prior art.
4. The following is a statement of reasons for the indication of allowable subject matter: although the Dymetman (US 6,330,976) reference teaches receiving position information of a coded data, the prior art of record fails to teach or fairly suggest either alone or in combination thereof a method of facilitating a communication using a product item, the product item including a surface having disposed thereon or therein coded data portions, each coded data portion encoding a product item identifier and position information identifying the position of the coded data portion on the surface of the product item, the method including the steps of:
 - receiving sensing data from a user device, the sensing data resulting from sensing one of the coded data portions and includes the product item identifier and position information of the sensed coded data portion;
 - extracting from the sensing data a message and a destination address;
 - sending to the provider address associated with the provider at least the message and the destination address; and
 - forwarding, by the provider, the message to the destination address.

Response to Arguments

5. A new grounds of rejection is made in view of claim language that the examiner contends is vague and indefinite.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMARA A. FRANKLIN whose telephone number is (571)272-2389. The examiner can normally be reached on Monday through Friday 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jamara A. Franklin/
Primary Examiner, Art Unit 2876

August 16, 2009
JAF

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